REMARKS

As reflected in the Listing of Claims, claims 1-27 are currently pending in this case.

In the Office Action dated September 8, 2005, the Examiner rejected claims 1-6, 8, 9, 12, and 26 under 35 U.S.C. § 102(b) as being anticipated by *Takahashi et al.* (U.S. Patent No. 5,887,193). Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Takahashi et al.* in view of *Humpleman et al.* (U.S. Patent No. 6,288,716). Claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Shigenobu* (JP 10-075424A).[1] Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Nonaka* (EP 0 955 635 A1). Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Maeda et al.* (U.S. Patent No. 5,559,780). Claims 16, 20, 21, 24, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Chihara* (JP 10-269757), which corresponds to U.S. Patent No. 6,678,462. Claims 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Chihara* and further in view of *Shigenobu*. Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view *Chihara* and further in view of *Nonaka*. Claims 17 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Chihara* and further in view of *Kimura* (JP 10-187380A). Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable

1 Applicants would like to note that the *Shigenobu* reference has not been listed on a PTO-892.

over *Takahashi et al.* in view of *Chihara* and further in view of *Kimura* and yet further in view of *Humpleman*.

Rejection of claims 1-6, 8, 9, 12, and 26 under 35 U.S.C. § 102(b)

In the Office Action dated September 8, 2005, the Examiner rejected claims 1-6, 8, 9, 12, and 26 under 35 U.S.C. § 102(b) as being anticipated by *Takahashi et al.* (U.S. Patent No. 5,887,193). Applicants respectfully traverse this rejection because *Takahashi et al.* fails to disclose each and every claim recitation. For example, independent claim 1 recites, *inter alia,* a portable recording and/or reproduction apparatus comprising:

> producing means for producing information for an operation screen including an area for displaying data stored in said storage medium and corresponding to said recording and/or reproduction means;

and independent claim 26 recites a similar recitation in a method form. The claimed recording and/or reproduction apparatus thus may act as a server side apparatus because the recording and/or reproduction apparatus produces information for an operation screen to be displayed on a terminal side apparatus. (*See, e.g.*, Specification at p. 87, 99, and 100.) The operation screen to be displayed further includes an area for displaying data stored in a storage medium of the recording and/or reproduction apparatus. Further, the operation information to be displayed in the terminal side apparatus is generated by the recording and/or reproduction apparatus. For example, the claimed recording and/or reproduction apparatus may generate display information including operating buttons (*See, e.g.*, Bt 15, 16, and etc. in Fig. 16.) and displayed data (*See, e.g.*, A21 in Fig. 16.).

Takahashi et al. fails to disclose at least the claimed producing means. On the contrary, *Takahashi et al.* discloses a multimedia controller 1 which receives a delegate object description file 210 from the digital VTR and generates the digital VTR delegate object 220 on the basis of the digital VTR delegate object description file 210. (*See Takahashi et al.,* col. 13, lines 45-64.) The digital VTR delegate object description file 210 merely "describes the specifications of a digital VTR data input/output delegate object which serves as a delegate to input or output data to or from the digital VTR 203." (*See Takahashi et al.,* col. 12, lines 48-53.) Thus, the digital VTR can be controlled by the multimedia controller 1, but the digital VTR, itself, is not capable of "producing information for an operation screen including an area for display data stored in said storage medium and corresponding to said recording and/or reproduction means." In short, the digital VTR of *Takahashi et al.* does not function as a server side apparatus. Because *Takahashi et al.* does not disclose each and every recitation of claim 1 or 26, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Moreover, Applicants respectfully note that the Office Action does not address the claimed "producing means," and therefore, independent claims 1 and 26 are allowable at least for this reason.

Dependent claims 2-6, 8-9, and 12 are also allowable at least for the reasons set forth above in connection with independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of dependent claims 2-6, 8-9, and 12 under 35 U.S.C. § 102(b) and the timely allowance of these claims.

Rejection of claims 7, 10, 11, 13-25, and 27 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 7, 10, 11, 13-25, and 27 under 35 U.S.C. § 103(a) because the prior art cited by the Examiner does not establish a *prima facie* case of obviousness. The prior art reference (or references when combined) do not teach or suggest all the claim elements. *See* M.P.E.P. § 2143.03.

For example, independent claim 16 recites, *inter alia*:

> discrimination means operable for discriminating a type of the external apparatus based on the transmission request information when transmission request information for requesting transmission of data is received from the external apparatus through said communication means;

and independent claim 27 also recites a similar recitation in a method form.

The claimed recording and/or reproduction apparatus may thus transmit data to different external apparatuses. For example, the recording and/or reproduction apparatus may thus transmit data in a different format based upon whether the recording and/or reproduction apparatus is connected to a personal computer or to another recording and/or reproduction apparatus. (*See, e.g.,* Specification at p. 115.)

The Examiner admits that *Takahashi et al.* does not disclose the claimed discrimination means. (*See Office Action* p. 8.) In an attempt to address these shortcomings, the Examiner relies on *Chihara*. However, *Chihara* also fails to disclose the above recitation. *Chihara* discloses a system and method for connecting an external server, through the use of a phone line, to household media electronic devices, which are in turn connected together using a bus and a gateway device. (*See Chihara,* col. 5, lines 3-9.) The gateway device manages the recording of data by disseminating recording duties to those media electronic devices that have the available storage

capacity to record the data. (*See Chihara,* Fig. 4.) At a request for playback of the data from a television set, the gateway device determines whether the data is of a type that can be reproduced directly on the television set. (*See Chihara,* col. 4, lines 46-48.) If the data is not of the type which can be reproduced directly on the television set, then the gateway device converts the file into a format which can be reproduced on the television set. Thus, *Chihara* discloses determining whether to convert a file to such a format by discriminating a data type. On the contrary, claims 16 and 27 recite "discriminating a type of the external apparatus." The apparatus and method set forth in claims 16 and 17 respectively, may transmit a different format of data to different apparatuses because the type of the external apparatuses are discriminated. *Chihara* can not process this function.

Thus, *Takahashi et al.* and *Chihara*, whether taken alone or in combination, fail to teach or suggest all of the elements of claims 16 and 27. The Examiner has therefore not met an essential criteria for establishing a *prima facie* case of obviousness, wherein "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *See* M.P.E.P. § § 2142, 2143, and 2143.03. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Dependent claims 17-25 are also allowable at least for the reasons set forth above in connection with independent claim 16. Accordingly, Applicants respectfully request withdrawal of the rejection of dependent claims 17-25 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

Moreover, Applicants respectfully traverse the Examiner's rejection of claims 7 under 35 U.S.C. 103(a) as being unpatentable over *Takahashi et al.* in view of *Humpleman et al.*; the rejection of claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Shigenobu*; the rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Nonaka*; and the rejection of claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over *Takahashi et al.* in view of *Maeda et al.* None of the references *Humpleman et al.*, *Shigenobu, Nonaka,* and *Maeda et al.* teach or suggest the claimed "producing means," nor does the Examiner rely on these references for such teachings. Claims 7, 10, 11, and 13-15 are thus allowable due to their dependency from claim 1.

Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 8, 2005

By: _____
Arthur A. Smith
Reg. No. 56,877